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10/817,107	04/02/2004	John W. Pastnak	IL-11131	2882

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EXAMINER

JOHNSON, STEPHEN

ART UNIT PAPER NUMBER

3641

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/817,107	Applicant(s) PASTRNAK ET AL.	
	Examiner Stephen M. Johnson	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-12 and 16-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3641

1. Applicant's election with traverse of species B (figs. 4-5) in the reply filed on 1/26/2006 is acknowledged. The traversal is on several grounds. (1) It is argued that the species included in figs. 1 and 2 are generic to all species. This not accurate. First, in the written description (page 7), figs. 1-2 are described as a first embodiment, figs. 4-5 as a second embodiment, and figs. 6-7 as a third embodiment. Secondly, the embodiment illustrated in figs. 1-2 contains structural elements not present in the elected species B (foot-hold 17, empty inner portion (see fig. 2)). As such, the species A embodiment cannot be accurately described as generic to the species B embodiment. (2) With regard to the argument that the species B embodiment contains all of elements in claim 1, while this may be the case, it is an argument that claim 1 is generic not an argument that species A is generic. (3) With regard to the argument that a combination/subcombination restriction requirement should have been made instead, this is not convincing for two reasons. First, it is the examiners choice as to how to restrict the case providing the restriction meets the rules as set in the MPEP, not applicant's. Secondly, a combination/subcombination restriction is not appropriate when generic claims are at issue. Combination/subcombination restriction requires an evidence claim (ABbr vs. Bsp) and this is not applicable in this case. (3) It is argued that the generic invention is AB; that species A comprises elements AB'; species B comprises elements ABC; and species C comprises elements ABD. In response, there seems to be some misunderstanding with regard to what the term generic claim means. In order for a claim to be generic, all the elements of the generic claim must be included in each of the different species. Consequently, the invention containing elements AB only cannot be considered to be generic because element B is not a part of species A (elements AB'). An invention containing element A only could be considered to be generic

Art Unit: 3641

because this element is common to all subsequent species. Further, claims are considered to be generic not embodiments. It is further argued that species A (figs. 1-3); species B (figs. 4-5); and species C (figs. 6-7) cannot be independent species of a generic claim. This argument is not convincing because it is not accurate. By way of example, a claim that is generic to all species is provided.

A blast effects shield comprising:

- a) a plurality of telescoping rings;
- b) means for extending and retracting the rings; and
- c) wherein a top ring of the plurality of telescoping rings is separated from a bottom ring by at least two additional rings.

(4) With regard to the argument that the click-lock mechanism for securing the rings together (illustrated in fig. 3) could be used with any of the other embodiments (species B or species C), the following explanation is given. In paragraphs [0012], [0013], and [0014], applicant specifically states his intention to use the click-lock mechanism of fig. 3 as an exemplary click-lock mechanism. Consequently, it is believed that this locking mechanism is intended to be used with any of the different species. Consequently, the features of fig. 3 (not figs. 1 and 2) will be included with the elected species B embodiment (figs. 4 and 5).

Applicant has elected species B (directed to figs. 3, 4, and 5) and an action on these claims follows. Claims 1-6, 8-12, and 16-22 read on the elected species and an action on these claims follows. Claim 7 is withdrawn from consideration as being directed to a non-elected species.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 3641

2. Claims 1-6, 8-12, and 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms “high-strength” and/or “low-density” throughout the claims are relative terms which renders the claim indefinite. The terms “high-strength” and/or “low-density” are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Usage of these terms to describe the strength and/or density of the composite fiber and matrix material makes the claims indefinite for the reasons given above.

3. Applicant’s arguments are directed to contextual usage of the terms “high strength” and “low density” in paragraph [0021] of the written disclosure as originally filed. In this regard paragraph [0021] provides numerous examples of materials that meet these descriptions as well as capabilities of both “high strength” as well as “low density” materials. However, this is not sufficient to provide a definition of these terms that would appraise a potential patent infringer as to the intended meets and bounds of the claim language.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5-6, 8-9, 11, and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Krzan (721).

Krzan (721) discloses a portable convertible blast shield comprising:

Art Unit: 3641

- | | |
|---|--------------------|
| a) at least 2 telescoping cylindrical rings; | 11, 12, 13, 14 |
| b) a telescopically-collapsed configuration; | see fig. 4 |
| c) a telescopically-extended configuration; | see fig. 3 |
| d) means for releaseably securing; | page 2, lines 4-29 |
| e) handles; | 29 |
| f) a second set of telescoping cylindrical rings; | 49 |
| g) a bladder; and | 60 |
| h) wheels attached to the outer ring. | 20, 25 |

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kranz (721) in view of Tabor.

Kranz applies as previously recited. However, undisclosed is an armor material that is comprised of a composite fiber and matrix material. Tabor teaches an armor material that is comprised of a composite fiber and matrix material (col. 4, lines 8-28). Applicant is substituting one armor material for another in an analogous art setting. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Tabor to the Kranz shield and have a shield with a different or particular type of armor material.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kranz (721) in view of Clemens.

Art Unit: 3641

Kranz applies as previously recited. However, undisclosed is an armor material that contains a ceramic liner. Clemens teaches an armor material that contains a ceramic liner (col. 3, lines 6-15). Applicant is substituting one type of armor material in an analogous art setting. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Clemens to the Kranz armor shield and have an armor shield with a particular or different type of armor material.

9. Claims 10 and 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Applicant's arguments with respect to claims 1-6, 8-12, and 16-22 have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Johnson whose telephone number is 571-272-6877 and whose e-mail address is (Stephen.Johnson@uspto.gov). The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The Central FAX phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 800-786-9199.

Application/Control Number: 10/817,107

Page 7

Art Unit: 3641



STEPHEN M. JOHNSON
PRIMARY EXAMINER

Stephen M. Johnson
Primary Examiner
Art Unit 3641

SMJ

March 4, 2006